

REMARKS

This application has been reviewed in light of the Office action dated September 24, 2008. Claims 94, 100, 104, 108 and 109 are presented for examination, of which Claims 94, 100 and 104 are in independent form and have been amended to define still more clearly what Applicants regard as their invention. Favorable reconsideration is respectfully requested.

In the outstanding Office Action, Claims 94, 100, 104, 108 and 109 were rejected under 35 U.S.C. § 103(a) as being obvious from Applicant Admitted Prior Art (AAPA) in view of U.S. Patent Application Publication 2001/0005833 (Asami), and also as being obvious from AAPA in view of U.S. Patents 7,678,787 (Walker et al.) and 6,167,382 (Sparks et al.)^{1/}

Asami is not Prior Art Against This Application

The Office Action states that while the present application has two priority dates, Applicants have not indicated which portion of the present application corresponds to which priority application. That is incorrect: as was clearly stated in the Request for

^{1/} In the Section 103(a) rejection over AAPA in view of *Walker* and *Sparks*, the Office Action appears to discuss claim language that was in the original claims, but that is not in the claims as presented in the last Amendment (dated June 2006). Also, the Office Action characterizes AAPA differently from in the Section 103(a) rejection over AAPA in view of *Asami*. In addition, in the Conclusion, the Office Action states that *Sparks* is a reference that has not been relied upon but is considered pertinent to Applicants' disclosure. Applicants cannot determine with any certainty the Examiner's interpretation of the AAPA, and thus cannot fully evaluate the rejection over AAPA in view of *Walker* and *Sparks*. Applicants therefore respectfully request that if a rejection on this set of prior art is made in the next Office Action, the Examiner state the grounds of rejection as clearly as possible, and making reference to the current claim language.

Reconsideration of October 6, 2006, the “April 28, 2000, filing date of the earlier of those Japanese patent applications[,] is prior to the December 22, 2000, U.S. filing date of *Asami*... [Applicants’] pending claims are fully supported by that priority application [emphasis added].” The premise ostensibly underlying the Examiner’s refusal to withdraw *Asami* as a reference is therefore factually incorrect.

Moreover, even if Applicants had not made the above-quoted statement, the Office had no right to “assume”, as the Office Action apparently does, that the claims are not fully supported by the earlier of Applicants’ priority applications. Once an applicant submits sworn translations of his priority applications, it is the duty of the Office to study the translations to determine whether the applicant is entitled to benefit of the priority date(s). That is, the Examiner is not entitled to make a presumption one way or the other on that question, but is obliged instead to study the translation(s) and make a definite determination:

“When the necessary papers are filed to overcome the date of the reference, the examiner’s action, if he or she determines that the applicant is not entitled to the priority date, is to repeat the rejection on the reference, stating the reasons why the applicant is not considered entitled to the date. If it is determined that the applicant is entitled to the date, the rejection is withdrawn in view of the priority date.

“If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date. If the applicant is found to be entitled to the date, the reference is simply not used but may be cited to applicant on form PTO-892. If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the papers are not in the English language and there is no translation, the examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant’s right to rely on the foreign filing date. [Emphases added]” MPEP § 201.15.

The Examiner's failure to study the submitted translation of the earlier priority application therefore was improper, and it is believed that his refusal to remove *Asami* as prior art against the present application also was plainly incorrect. Applicants submit, again, that *Asami* is not prior art against this application.

The Present Application Discloses Novel, Useful Contribution to the Art

As has been well known, it is good to collect and recycle certain used items, such as used toner cartridges. If a customer returns such an item to the manufacturer, he may not get back anything comparable to the item's value when it was brand new because it is now barely useful to other customers without further processing. To encourage customers to return such used items, though, the manufacturer could reward each customer with an incentive based on a collecting rate, which indicates how many items the customer has returned compared to how many items he has purchased (\$6 in Fig. 2). Normally, the higher the collecting rate, the higher the reward (Fig. 20).

Therefore, according to a conventional process of collecting used items, upon a customer's returning a used item, a collecting center calculates a collecting rate for the customer, sets an incentive based on the collecting rate as a reward for returning the used item, and informs the customer of the incentive by regular mail (para. [0008]). However, many errors could occur during such a slow and troublesome collecting process. For example, the collecting rate may turn out to be more than 100% because the user might have returned some items that he ordered from another manufacturer (para. [0109]-[0113]), and so on. When that happens, any incentive set for the user would be unreasonable. There should be safeguards against such errors.

The present invention has been made to address such issues. It relates to an apparatus and its control method which implement a more streamlined and effective collecting process. Specifically, the method verifies that the collecting rate is equal to or less than 100% (Fig. 18A). If that's not the case, the method checks with the user to find out what might have led to the unexpectedly large collecting rate. If the user doesn't respond, the method suspends the calculation of the incentive; otherwise, the method adjusts the collecting rate appropriately.

All Recitations of The Claims of the
Present Application Are Entitled to Patentable Weight

The Office Action states that the phrase “of a used... from a user” in the inputting step of Claim 100 is “not a positively recited method step but is mere intended use of the collected data and thus having no patentable weight.” Applicants respectfully disagree.

“Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: ‘A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon.’ was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).” MPEP § 2173.05(q).

“Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” MPEP § 2106.

First of all, in the recitation “inputting collecting data of a used consumable returned from a user” recited in Claim 100, “a used consumable” means a consumable item – such as a toner cartridge – that is used rather than new, “returned from a user” means that the item is

being returned from a user leading to a collection of the item from the user, and “collecting data” means information regarding the return or collection – regarding the items returned, date of return, manner of return, etc. (Figs. 8-10).

Accordingly, the recitation clearly sets forth a positive step of inputting certain collecting data, along with the other positive steps set forth in the claim. Specifically, “of a used consumable returned from a user” qualifies “collecting data,” thereby “limit[ing] a claim to a particular structure” and restricting the scope of the claim, as recited in MPEP § 2106. In addition, while it may have described the past use of the consumable, it in no way indicates the intended use. By the same token, the limitation recites “functional descriptive material,” as it describes specific functionality of a method for controlling a server that could be implemented on a computer.

A similar reasoning applies to the phrase “to report... to the user.” Objections to these phrases are respectfully requested.

Even If *Asami* Were Prior Art,
Applicants’ Claims Would Be Patentable

In addition to the features discussed above, Claim 100 also recites, among other features, “sending an inquiry to the user regarding why the collecting rate is greater than 100%, and suspending operation of said second calculator if the user does not respond or adjusting the collecting rate otherwise.”

The feature recited above is not believed to be disclosed or taught in *AAPA* or *Asami*, considered alone or in any permissible combination.

As discussed earlier, *AAPA* does not disclose any proper error handling procedure inquiring the user to find out what might have led to a greater-than-one collecting rate. Therefore, it does not disclose or suggest “sending an inquiry to the user regarding why the collecting rate is greater than 100%, and suspending operation of said second calculator if the user does not respond or adjusting the collecting rate otherwise,” as recited in Claim 100.

Asami pertains to a capability of permitting the viewing and use of award points on a website in the context of a product sale system and to a capability of linking resale and purchase of used products. As discussed in the Request for Reconsideration of October 6, 2006, the *Asami* system differs from the embodiments of the present invention disclosed in the present application in that it uses awards to encourage resales rather than returns (*see* para. [0002] of *Asami*). In other words, in *Asami*, a used item as-is may be demanded by customers who currently do not own the item, and adjustment of awards is generally determined by such demands; in the present application, however, a used item as-is is probably not desirable to other customers, and adjustment of awards or incentives is generally determined by collecting rates of the same customers who currently own the item.

Consequently, *Asami* does not involve collecting rate calculation or error handling for suspending collecting rate calculation or fixing the collecting rate, which means that it does not disclose or suggest “sending an inquiry to the user regarding why the collecting rate is greater than 100%, and suspending operation of said second calculator if the user does not respond or adjusting the collecting rate otherwise,” as recited in Claim 100.

Accordingly, at least for the reasons noted above, Claim 100 is believed to be patentable over *AAPA* in view of *Asami*.

Finally, *Walker* and *Sparks* similarly do not concern collecting rate calculation at all. Even assuming that they show all that they are cited for, that would not remedy the deficiency in the *AAPA* as prior art against Applicants' claims, as discussed above. Accordingly, Claim 100 is believed to be patentable over *AAPA* over *Walker* and *Sparks* for the same reasons as noted above.

Claims 94 and 104 are machine and storage medium claims corresponding to method Claim 100 and are believed to be patentable for the same reasons as noted above in connection with Claim 100.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from Claim 94, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and allowance of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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